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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,100	04/07/2004	James N. Vinci	2926B/R-02	9503
<div>7590 10/09/2007</div> <div>Teresan W. Gilbert The Lubrizol Corporation Patent Dept./Mail Drop 022B 29400 Lakeland Boulevard Wickliffe, OH 44092-2298</div>				
			<div>EXAMINER</div> <div>TOOMER, CEPHIA D</div>	
			<div>ART UNIT</div> <div>1797</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>10/09/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,100

Applicant(s)

VINCI, JAMES N.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,8,10,11 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8,10,11 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the amendments filed June 29, 2007 and July 19, 2007 in which claims 1, 10 and 17 were amended and claim 21 was added.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6, 8, 10, 11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichihashi (US 5,792,731) in view of Nibert (US 5,750,476).

Ichihashi teaches a lubricant composition for transmissions comprising a phosphorus-based extreme pressure agent and an alkaline earth metal-based detergent (see abstract).

The phosphorus-based compound may be a phosphite of the formula $(RO)_3P$ wherein R is a C_3 - C_{30} alkyl or C_6 - C_{30} aryl (see col. 3, line 55 through col. 4, lines 1-20). The phosphite is present in the composition in an amount from 0.05-5 wt.% (see col. 4, lines 64-67).

The alkaline earth metal-based detergent may be a carboxylic acid acylating agent such as, a sulfonate or salicylate (see col. 5, lines 4-11). The TBN of the detergent is in the range of 80-350 mg KOH/g. The detergent is present in the composition in an amount from 0.05 - 8 wt% (see col. 5, lines 4-25). The composition of

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Ichihashi meets the limitations of the claims regarding the ratio of equivalents because the equivalents of the overbased material is for 160-701 and the equivalents of the phosphite is such that the ratio of overbased material to phosphite is at least one.

Applicant's intended use is given no patentable weight because intended use is given no patentable when the claims are directed to the composition per se.

Ichihashi teaches the limitations of the claims other than that a friction modifier is present in the composition and that the friction modifier is a glycerol ester or a borated glycerol ester. However, Nibert teaches this difference.

Nibert teaches a lubricant for transmission fluids comprising oil-soluble phosphorus containing compounds, overbased metallic salts and polyol esters such as glycerol mono-oleate (see abstract; col. 7, lines 35-65; col. 8, lines 40-45; col. 9, lines 22-28). The polyol ester friction modifiers may be used in an amount from 0.01 to 10 wt% of the finished lubricant (see col. 9, lines 29-33).

It would have been obvious to one of ordinary skill in the art to include a glycerol ester friction modifier because Ichihashi teaches that his transmission composition, containing compounds similar to those set forth in Nibert, is capable of transmitting a large amount of torque (see col. 1, lines 37-52) and Nibert teaches transmission fluids such as those used in Ichihashi must have a very good friction versus velocity relationship, therefore, the addition of friction modifiers such as glycerol esters imparts this desired property.

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichihashi (US 5,792,731) in view of Tipton (US 5,620,948).

Ichihashi teaches a lubricant composition for transmissions comprising a phosphorus-based extreme pressure agent and an alkaline earth metal-based detergent (see abstract).

The phosphorus-based compound may be a phosphite of the formula $(RO)_3P$ wherein R is a C_3 - C_{30} alkyl or C_6 - C_{30} aryl (see col. 3, line 55 through col. 4, lines 1-20). The phosphite is present in the composition in an amount from 0.05-5 wt.% (see col. 4, lines 64-67).

The alkaline earth metal-based detergent may be a carboxylic acid acylating agent such as, a sulfonate or salicylate (see col. 5, lines 4-11). The TBN of the detergent is in the range of 80-350 mg KOH/g. The detergent is present in the composition in an amount from 0.05 - 8 wt% (see col. 5, lines 4-25). The composition of Ichihashi meets the limitations of the claims regarding the ratio of equivalents because the equivalents of the overbased material is for 160-701 and the equivalents of the phosphite is such that the ratio of overbased material to phosphite is at least one.

Applicant's intended use is given no patentable weight because intended use is given no patentable when the claims are directed to the composition per se.

Ichihashi teaches the limitations of the claims other than that a friction modifier is present in the composition and that the friction modifier is a borated glycerol ester. However, Tipton teaches this difference.

Tipton teaches an additive composition for a functional fluid, particularly useful for transmissions wherein the composition comprises a boron compound (see abstract).

The boron compound may be borated fatty acid esters of glycerol (see col. 14, lines 29-35).

It would have been obvious to one of ordinary skill in the art to include borated glycerol esters in the composition because Ichihashi teaches that his composition allows the transmittance of large capacity of torque when it is applied to the transmission and Tipton teaches that his composition comprising a borated glycerol ester enhances the torque characteristics of transmission fluid.

4. Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ichihashi teaches that his composition keeps the coefficient of friction high for a long period of time and is capable of transmitting a large amount of torque (see col. 1, lines 44-52). Nibert

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teaches that friction modifiers enhance the benefit of his composition, which is a very good friction versus velocity relationship, which a property desired by Ichihashi.

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cepha D. Toomer
Primary Examiner
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